

EXPRESS MAIL NO. EV 335614427US

PTO/SB/26 (08-03)

Approved for use through 07/31/2006. OMB 0651-0031

U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

**TERMINAL DISCLAIMER TO OBVIATE A DOUBLE PATENTING
REJECTION OVER PRIOR PATENTS**

Docket Number (Optional)
690068.412C4

In re Application of: Lawrence Steinman et al.

Application No. 10/820,983

Filed: April 8, 2004

**For: METHODS FOR TREATMENT OF MULTIPLE SCLEROSIS USING PEPTIDE
ANALOGUES AT POSITION 91 OF HUMAN MYELIN BASIC PROTEIN**

The owners*, Neurocrine Biosciences, Inc. and Stanford University Medical Center of 100 percent interest in the instant application hereby disclaim, except as provided below, the terminal part of the statutory term of any patent granted on the instant application, which would extend beyond the expiration date of the full statutory term defined in 35 U.S.C. 154 and 173, as presently shortened by any terminal disclaimer, of prior Patent Nos. 6,369,033, 6,489,299 and 6,740,638. The owners hereby agree that any patent so granted on the instant application shall be enforceable only for and during such period that it and the prior patents are commonly owned. This agreement runs with any patent granted on the instant application and is binding upon the grantee, its successors or assigns.

In making the above disclaimer, the owners do not disclaim the terminal part of any patent granted on the instant application that would extend to the expiration date of the full statutory term as defined in 35 U.S.C. 154 and 173 of the prior patents, as presently shortened by any terminal disclaimer, in the event that it later: expires for failure to pay a maintenance fee, is held unenforceable, is found invalid by a court of competent jurisdiction, is statutorily disclaimed in whole or terminally disclaimed under 37 CFR 1.321, has all claims canceled by a reexamination certificate, is reissued, or is in any manner terminated prior to the expiration of its full statutory term as presently shortened by any terminal disclaimer.

Check either box 1 or 2 below, if appropriate.

1. ☐ For submissions on behalf of an organization (e.g., corporation, partnership, university, government agency, etc.), the undersigned is empowered to act on behalf of the organization.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

2. ☒ The undersigned is an attorney or agent of record.

Signature

February 3, 2005

Date

William T. Christiansen, Ph.D.

Typed or printed name

(206) 622-4900

Telephone Number

- ☒ Terminal disclaimer fee under 37 CFR 1.20(d) included.

WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.

*Statement under 37 CFR 3.73(b) is required if terminal disclaimer is signed by the assignee (owner).
Form PTO/SB/96 may be used for making this certification. See MPEP § 324.

This collection of information is required by 37 CFR 1.321. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

02/08/2005 HAHMED1 00000034 10820983

130.00 DP

01 FC:1814

Effective on 12/08/2004.

Fees pursuant to the Consolidated Appropriations Act. 2005 (H.R. 4818).

FEE TRANSMITTAL **for FY 2005**

☐ Applicant claims small entity status. See 37 CFR 1.27

TOTAL AMOUNT OF PAYMENT (\$)**130**
Complete if Known

| | |
|----------------------|-------------------|
| Application Number | 10/820,983 |
| Filing Date | April 8, 2004 |
| First Named Inventor | Lawrence Steinman |
| Examiner Name | Jeffrey E. Russel |
| Art Unit | 1654 |
| Attorney Docket No. | 690068.412C4 |

METHOD OF PAYMENT (check all that apply)

- ☒ Check ☐ Credit Card ☐ Money Order ☐ Other (please identify): _____
☐ Deposit Account Deposit Account Number: 19-1090 Deposit Account Name: Seed IP Law Group PLLC
 For the above-identified deposit account, the Director is hereby authorized to: (check all that apply)
☐ Charge fee(s) indicated below ☐ Charge fee(s) indicated below, **except for the filing fee**
☐ Charge any additional fee(s) or underpayments ☒ Charge any underpayments or credit any overpayments of fee(s) under 37 CFR 1.16 and 1.17

Warning: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.

FEE CALCULATION**1. BASIC FILING, SEARCH, AND EXAMINATION FEES**

| Application Type | FILING FEES | | | SEARCH FEES | | EXAMINATION FEES | | Fees Paid (\$) |
|------------------|-------------|-----------------------|-----------------------|-----------------------|-----------------------|-----------------------|-----------------------|----------------|
| | Fee (\$) | Small Entity Fee (\$) | Small Entity Fee (\$) | Small Entity Fee (\$) | Small Entity Fee (\$) | Small Entity Fee (\$) | Small Entity Fee (\$) | |
| Utility | 300 | 150 | 500 | 250 | 200 | 100 | | |
| Design | 200 | 100 | 100 | 50 | 130 | 65 | | |
| Provisional | 200 | 100 | 0 | 0 | 0 | 0 | | |

2. EXCESS CLAIM FEES

| Fee Description | Fee (\$) | Small Entity Fee (\$) |
|---|----------|-----------------------|
| Each claim over 20 or, for Reissues, each claim over 20 and more than in the original patent | 50 | 25 |
| Each independent claim over 3 or, for Reissues, each independent claim more than in the original patent | 200 | 100 |
| Multiple dependent claims | 360 | 180 |

| Total Claims | Extra Claims | Fee (\$) | Fee Paid (\$) | Multiple Dependent Claims |
|--|--------------|----------|---------------|---------------------------|
| <u>6</u> -20 or HP = <u>00</u> X _____ = _____ | | | | Fee (\$) |
| HP = highest number of total claims paid for, if greater than 20 | | | | |

| Indep. Claims | Extra Claims | Fee (\$) | Fee Paid (\$) |
|---|--------------|----------|---------------|
| <u>2</u> -3 or HP = <u>00</u> X _____ = _____ | | | |

HP = highest number of total claims paid for, if greater than 3

3. APPLICATION SIZE FEE

If the specification and drawings exceed 100 sheets of paper, the application size fee due is \$250 (\$125 for small entity) for each additional 50 sheets or fraction thereof. See 35 U.S.C. 41(a)(1)(G) and 37 CFR 1.16(s).

| Total Sheets | Extra Sheets | Number of each additional 50 or fraction thereof | Fee (\$) | Fee Paid (\$) |
|--------------------|--------------|--|----------|---------------|
| _____ -100 = _____ | /50 = _____ | _____ (round up to a whole number) | x _____ | _____ |

HP = highest number of total claims paid for, if greater than 20

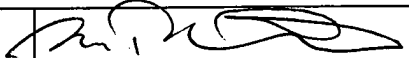
4. OTHER FEE(S)

Non-English Specification, \$130 fee (no small entity discount)

Other: Statutory Disclaimer

| | | | | | |
|--|--|--|--|--|--|
| | | | | | |
| | | | | | |
| | | | | | |

SUBMITTED BY

| | | | | | |
|-------------------|---|-----------------------------------|--------|-----------|------------------|
| Signature |  | Registration No. (Attorney/Agent) | 44,614 | Telephone | 206-622-4900 |
| Name (Print/Type) | William T. Christiansen, Ph.D. | | | Date | February 3, 2005 |